

REMARKS

I. Status of the Claims

Claims 1, 7-18, 20-27, 33-44, 46-60, 66-89, 95-106, 108-117, and 119-122 are presently pending in the application. Without prejudice or disclaimer, claims 14, 24-25, 40, 57-58, 60-82, 86-114, and 116-117 are cancelled. Without prejudice or disclaimer, claims 1, 15, 18, 20, 21, 26, 27, 41, 44, 46, 47, 59 and 115 are amended. Support for the amendment can be found in the original claims. See e.g., claims 14 and 25. Accordingly, there is no written description issue raised by this amendment.

II. Interview Summary

Applicants' representatives respectfully thank Examiner Rogers for his time discussing the application on August 3, 2010. The Examiner indicated he would be willing to enter the proposed amendment to claim 1 and commented that the amendment would place the claim in a better position for appeal before the board. No agreement was reached on the allowability of the claims. The Examiner still did not agree that the tests data provided in the Declaration of October 5, 2009, was enough to overcome the obviousness rejection on record. Accordingly, Applicants agree with the Interview Summary dated August 5, 2010, in that no agreement was reached.

III. Declaration

The Examiner alleges that "[t]he declaration under 37 CFR 1.132 filed 10/05/2009 is insufficient to overcome the rejection of claims 1,7-18,20-27,33-44,46-

60,66-89,95-106,108-117 and 119-122 based upon 35 U.S.C. 103(a) as being unpatentable over Arnaud. . . .” Final Office Action at 2. Specifically, the Examiner states that “it is not clear how composition 5 and 7 (comparative examples) relates [sic] to the prior art cited by the examiner, Arnaud.” *Id.* The Examiner notes that “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” *Id.* The Examiner further notes that “finding the optimum type of oil in order to achieve the desired hardness levels in a lipstick is hardly unexpected since a harder lipstick would be a desirable property for such a cosmetic and this property would be adjusted by known selection processes for the various constituent ingredients of the lipstick.” *Id.* The Examiner maintains the rejection of the claims because “the declaration does not compare applicants claimed invention with Arnaud.” *Id.* at 4. Applicants respectfully disagree with the Examiner.

However, in further support of the arguments on record, Applicants submit herewith the Declaration under 37 C.F.R. §1.132 of Virginie Perez Nowak, (“Second Declaration”). Arnaud teaches a long list of oils and esters, with no regard whatsoever for molecular mass. See Arnaud col. 3, line 25 - col. 4, line 41 and col. 5, line 21, - col. 6, line 13. In the Second Declaration, Composition 1 is was prepared according to the present claims with diisostearyl malate as the ester oil. Comparative Compositions 2 and 3 were prepared with different ester oils recited in Arnaud: isopropyl myristate, and noepentyl diheptanoate. Thus, the Second Declaration compares compositions according to the present claims and Arnaud. As discussed below, the Second Declaration shows the unpredictability in the art with respect to the effects of the choice of the at least one non-volatile ester oil.

IV. Rejections under 35 U.S.C. § 103

A. Arnaud

The Examiner maintains the rejection of claims 1, 7-18, 20-27, 33-44, 46-60, 66-89, 95-106, 108-117 and 119-122 under 35 U.S.C. § 103(a) as allegedly being “unpatentable over Arnaud” for the reasons of record. Final Office Action at 3. Moreover, the Examiner states that “[a]n affidavit or declaration under 37 CFR [§] 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness.” *Id.* at 2.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int’l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary considerations. 148 U.S.P.Q. at 467. “Such evidence . . . may include evidence of . . . unexpected results.” M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See *Graham*, 148 U.S.P.Q. 467; *see also KSR*, 82 U.S.P.Q. 2d at 1388.

In further support of the arguments on record, Applicants submit herewith the Second Declaration. Submission of the Second Declaration in no way indicates that Applicants concede that the Examiner has established a *prima facie* case of obviousness. Instead, the Second Declaration clearly shows the unexpected/unpredictable results attributable to the claimed composition reciting specific non-volatile ester oils. By its very nature, an obviousness rejection is based on the Examiner's assumption that similar compositions will exhibit similar properties. However, the Second Declaration merely demonstrates that such an assumption is incorrect with respect to the compositions of the present claims.

In the Second Declaration, a series of comparative tests are performed. Composition 1 is Example 4 from the present specification, and was prepared according to the present claims. Compositions 2, and 3 were prepared with two ester oils recited in Arnaud. See Second Declaration, Table 1.

The comparative tests show that sticks of Composition 1 have a higher measured hardness. See *id.*, Table 2. The quantitative differences in hardness are statistically significant. The cosmetic evaluations also show qualitative differences. The deposit realized with the sticks of Composition 1 was homogenous and not oily (not greasy). On the contrary, the deposits realized with Comparative Compositions 2 and 3 were heterogenous and greasy (oily). See *id.*, Table 3. The deposit realized with the sticks Composition 1 was glossy and exhibited a good level of wear of the glossiness and a medium level of wear of color. On contrary, the deposits realized with Comparative Compositions 2 and 3 exhibited a poor level of wear of the glossiness and a poor level of wear of color. See *id.* The qualitative differences presented in Table 3 in

the Declaration are at least of the type used on a regular basis by L'Oréal to draw distinctions between different compositions.

These results are unexpected in view of Arnaud, and show unpredictability in the art. See *id.* at ¶¶ 17-20, Table 3.

Arnaud provides no guidance to one of ordinary skill in the art to the specific combination of at least one high viscosity phenylsilicone oil chosen from the oils of formula (A), at least one low viscosity phenylsilicone oil having a viscosity of less than 500 cst, and at least one non-volatile ester oil chosen from penta-erythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triiso-stearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate.

Thus, the Examiner has not established a *prima facie* case of obviousness in light of the unpredictability shown by the data in the First and Second Declarations, as well as the arguments of record. Accordingly, this rejection should be withdrawn.

B. Arnaud in view of Willemin

The Examiner maintains the rejection of claims 1, 7-18, 20-27, 33-44, 46-60, 66-89, 95-106, 108-117 and 119-122 under 35 U.S.C. § 103(a) as allegedly being “unpatentable over Arnaud” in view of U.S. Patent No. 6,592,855 to Willemin et al. (“Willemin”) for the reasons of record. Final Office Action at 3. Applicants respectfully disagree for the reasons of record.

Furthermore, Willemin does not cure the deficiencies of Arnaud discussed above, i.e., it does not offer any guidance to one of ordinary skill in the art to the combination of

at least one high viscosity phenylsilicone oil chosen from the oils of formula (A), at least one low viscosity phenylsilicone oil having a viscosity of less than 500 cst, and at least one non-volatile ester oil recited in the present claims.

Accordingly, Applicants respectfully submit that the rejection should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4077.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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